REMARKS

Claims 21-43 are pending in the case. Claim 21 is herein amended to more particularly point out and distinctly claim the subject matter of the invention. Support for the amendment can be found, for example, at page 3, line 32 through page 4, line 4, and page 4, line 23 through page 5, line 8. New claims 34-43 are herein added. Support for claims 34 and 35 can be found, for example, at page 4, lines 14-17 and 31 and at page 7, lines 30-32. Support for claims 36 and 37 is found at page 5, line 10 and page 6, line 5 through page 7, line 10 as well as Examples 1 through 6. Support for claims 38 and 39 can be found, for example, at page 8, lines 4-14 and Examples 1 through 6. Support for claims 40 and 41 can be found at page 9, lines 10-14. Support for claim 42 can be found at page 7, lines 30-33 and that for claim 43 can be found at page 8, lines 10-11. No new matter has been introduced.

Objection to the Specification

The specification is objected to under 35 U.S.C. § 112, first paragraph, as allegedly failing to adequately teach how to make and/or use the invention, and thereby failing to provide an enabling disclosure. Specifically, the Examiner states that the specification "fails to provide information that would allow the skilled artisan to practice the instant invention without undue experimentation" and that "[a]pplicant fails to set forth the criteria that defines that would be a 'Selective Estrogen Receptor Modulator' or an 'agent which exhibits progestogenic activity (which) is effective to modulate the side effects of the Selective Estrogen Receptor Modulator.'"

Further, on page 10, ¶2 of the Office Action, the Examiner goes on to state that "[a]pplicant's rebuttal arguments regarding selective estrogen receptor modulators (SERM) have been considered, but are unconvincing. ***The instant rejection is for undue***

experimentation, not a failure to conceptually grasp the SERM nature." (emphasis added)

In connection with this rejection, the Examiner cites *In re Wands*, 8 USPQ2d 1400 (Fed. Cir. 1988), listing eight (8) factors set forth therein, and states that the examples given in the present specification are "neither exhaustive, nor define the class of compounds required" (*see* page 3, ¶2 of the Office Action). Further, the Examiner states that the pharmaceutical art is unpredictable, requiring each embodiment to be individually assessed for physiological activity.

Applicants respectfully but totally traverse the statement.

The Examiner made the same rejection citing *Wands* in the "Examiner's Answer" during the appeal proceeding for the parent application, application serial no. 09/059,476, of the present application, which has exactly the same as the present specification. The claims of the parent application were directed to (i) an improvement of the method of preventing hormonal dependent breast cancer by coadministering a SERM and an agent which exhibits progestogenic activity to modulate the side effects of the SERM; and (ii) a kit comprising a SERM and a progestogenically active compound. Remanding the case, the Board of Patent Appeals and Interferences (the "Board") requested the examiner to consider the court's opinion in *Enzo Biochem. Inc. v. Calgene, Inc.*, 188 F.3d 1362, 52 USPQ2d 1129 (Fed. Cir. 1999). As a result of such consideration, the rejection was withdrawn and all the claims were allowed.

It is respectfully submitted that, as the Board indicated, *Enzo Biochem. Inc.* provides a model of a fact-based application of the *Wands* factors to claims. In that case, the court stated that "[w]e have held that a patent specification complies with the statute [35 U.S.C. § 112, first paragraph] even if a 'reasonable' amount of routine

experimentation is required in order to practice a claimed invention, but that such experimentation must not be 'undue'", citing *In re Wands*, 858 F.2d at 736-37, 8 USPQ2d at 1404 ("Enablement is not precluded by the necessity for some experimentation such as routine screening. However, experimentation needed to practice the invention must not be undue experimentation. The key word is 'undue,' not 'experimentation.'"). Further, the court goes on to state that "[t]he determination of what constitutes undue experimentation in a given case requires the application of a standard of reasonableness, having due regard for the nature of the invention and the state of the art." (citing *Ansul Co. v. Uniroyal, Inc.* 448 F.2d 872, 878-79; 169 USPQ 759, 762-63 (2d Cir. 1971), *cert. denied*, 404 U.S. 1018; 172 USPQ 257 (1972)).

With regard to the issues of amount of direction or guidance presented and predictability, the court stated that "[i]t is well settled that patent applicants are not required to disclose every species encompassed by their claims, even in an unpredictable art. However, there must be a sufficient disclosure, either through illustrative examples or terminology, to teach those of ordinary skill how to make and use the invention as broadly as it is claimed." (citing *In re Vaeck*, 947 F.2d 488, 496 and n.23, 20 USPQ2d 1438, 1445 and n.23 (Fed. Cir. 1991).

Applicants respectfully submit that, as was exactly the case with the parent application, the present specification provides many examples of ***known SERMs*** (*see* page 5, line 6 through page 7, line 10) as well as their ***known uses*** in treating or controlling an estrogen sensitive conditions, such as contraception, hormone replacement therapy, endometriosis, leiomyoma, dysfunctional uterine bleeding, hormonal dependent cancers, etc. (*see* page 4, line 23 through page 5, line 5). The specification clearly states, starting at page 7, line 11, that "[t]he SERM aspect of the present invention is similar to the previous use of such materials for the treatment of estrogen dependent or other medical conditions. ***Thus, not only may any known SERM***

be employed, but also the dosage amount and mode of administration heretofore employed can also be employed." (emphasis added) In addition, sufficient working examples are provided under "Examples" starting at page 11 of the specification.

Thus, the specification does ***not*** merely provide "conceptual grasp of the SERM nature", as the Examiner contends, but clearly set forth how to make and/or use the invention ***without undue experimentation*** on the part of one skilled in the art. In addition, Applicants previously submitted several references which support the enabling disclosure of the present specification at the time of the filing. The Examiner's objection appears to ignore the state of art at the time of the filing of the present application.

Likewise, the present specification discloses the clear criteria for progestogenically active compounds and their uses with plenty of example compounds and sufficient working examples (*see* page 7, line 30 through page 9, line 24; and Examples starting at page 11).

Thus, the present specification is sufficient to teach those of ordinary skill in the art how to make and use the invention as claimed.

Accordingly, the objection to the specification under 35 U.S.C. § 112, first paragraph, as failing to provide an enabling disclosure should be withdrawn.

Claim Rejections under 35 U.S.C. § 112

Claims 21-33 are rejected under 35 U.S.C. § 112, first paragraph, for the reasons set forth in the objection to the specification. Further, claims 21-33 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the

invention. Specifically, the rejection states that "[c]riteria defining medicaments that are 'Selective Estrogen Receptor Modulator(s)', or 'agent(s) which exhibits progestogenic activity (which) is effective to modulate the side effects of the Selective Estrogen Receptor Modulator' are not set forth in the specification, thereby failing to provide information defining the instant inventions metes and bounds." The Examiner also states that the phrase "modulate" renders claims 21-33 indefinite.

Applicants respectfully traverse both rejections for the same reasons presented in the previous section.

Nonetheless, with regard to the rejection under 35 U.S.C. § 112, ¶2, claim 21 is herein amended to replace the term "modulate" with "preventing, ameliorating and eliminating", which further particularly point out and distinctly claim the subject matter which applicants regard as the invention. New claims 34-43 are also herein added. The amendments and new claims are well supported in the present specification as indicated at the beginning of the present Remarks.

Accordingly, applicants respectfully request that all claim rejections under 35 U.S.C. § 112, first and second paragraphs, be withdrawn.

Claim Rejections under 35 U.S.C. § 103

Claims 21-33 are rejected under 35 U.S.C. § 103 as being allegedly unpatentable over *Jones et al.* (U.S. Patent No. 4,133,814; "*Jones*"); *Basu* (*Jap. J. Exp. Med.*, 1973, 43(1):9-15; "*Basu*"); *Shane et al.* (*Fertil. Steril.*, 1978, 29(6):692-4; "*Shane*"), in view of *Merck Manual*. The rejection states that "[i]t is generally considered prima facie obvious to combine compounds each of which is taught by the prior art to be useful for the same purpose, in order to form a composition which is to be used for the very same

purpose." However, the Examiner acknowledges that the claims 21-33 differ from the references as to:

(1) the concomitant employment of these medicaments

(2) administration levels of the medicaments, and

(3) recitation of bleeding amelioration.

Applicants respectfully disagree with the rejection, particularly, in view of the amendment and new claims.

Unlike the Examiner's contention and in addition to the points the Examiner acknowledges, all cited prior art references merely teach the use of the disclosed compounds for contraceptive purposes, but do not teach or even suggest, each alone or in combination, an improvement of such a use of the compounds or methods of preventing, ameliorating or eliminating side effects, such as uterine bleeding, that accompany the contraceptive use of SERMs. None of the references motivates one skilled in the art to combine them to come up with the invention recited in the claims as amended and the new claims. The new claims are presented not as Jepson-type claims directed to contraceptives, but as claims directed to methods of preventing, ameliorating or eliminating dysfunctional uterine bleeding that accompanies contraceptive administration of SERMs. None of the references discloses such a method.

Merck Manual describes irregular bleeding during the early part of oral contraceptive pill administration as a normal occurrence that is self-limiting. Thus, Examiner argues that conventional oral contraceptive pills inherently provide the amelioration of such bleeding.

The amendment to claim 21 makes the claim directed to the improvement of the method of achieving contraception by preventing, ameliorating or eliminating the bleeding side effects of the SERM. The new claims are directed to a method of "preventing, ameliorating or eliminating dysfunctional uterine bleeding that accompanies contraceptive administration of a Selective Estrogen Receptor Modulator." Thus, neither set of the claims relies on any self-limiting nature of the bleeding caused by the conventional oral contraceptives.

Thus, the present claims are not obvious at all over any of the cited references, each alone or in combination.

Accordingly, Applicants respectfully request that all rejections under 35 U.S.C. § 103 be withdrawn.

Additional Comments by the Examiner

At page 9, last paragraph, the Examiner objects to the claimed invention as it provides "contraception in **premenopausal human**" [*sic*] females: which group reads on any female who is not menopausal", and suggests to use the term "peimenopause [*sic*]".

Applicants could not fully understand the point the Examiner is making, as perimenopausal females also use contraception as do premenopausal females and such distinction in these two groups seems to be irrelevant in relation to the present invention.

In addition, in relation to the issue of "undue experimentation", the Examiner cites *General Electric Company v. Wabash Appliance Corporation et al.*, 37 USPQ 466 (US 1938) and *University of California v. Eli Lilly and Co.*, 43 USPQ2d 1398 (Fed. Cir. 1997),

regarding "functional language at the point of novelty." As is the case for *In re Wands*, the Examiner also cited the cases in his "Examiner's Answer" during the appeal proceeding for the parent application, application serial no. 09/059,476, of the present application. Applicants repeat the same response as their reply to the Examiner's Answer at that time.

The *University of California* case is explicityly limited to cDNA which "is not defined or described by, the mere name 'cDNA' even if accompanied by the name of the protein that it encodes" *Id.* at 1406. The present invention does not relate to cDNA. In addition, the present claims are not "functional at the point of novelty" as the nature and uses of SERMs and progestogenically active compounds were well known at the time of the invention and the present specification discloses exactly that.

Applicants believe that all claims are now in condition for allowance, an early notification of which is earnestly requested.

No fee, other than the fess for the extension of time, is believed to be due for this Amendment. Should any fees be required, please charge such fees to Deposit Account No. 50-2215.

Respectfully submitted,

Dated: February 20, 2004

By _____

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